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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,816	03/10/2004	Nicole S. Carpenter	BUR920000141US2	7130
29505	7590	11/21/2006	EXAMINER	
DELIO & PETERSON, LLC 121 WHITNEY AVENUE NEW HAVEN, CT 06510			KACKAR, RAM N	
			ART UNIT	PAPER NUMBER
			1763	

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/798,816

Applicant(s)

CARPENTER ET AL.

Examiner

Ram N. Kackar

Art Unit

1763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11 and 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 11 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sayka et al (US 6766813) in view of Lyle O. Malotky (US 5120369).**

Sayka et al disclose an apparatus for removing contaminate particulate matter from a semiconductor wafer and disclose a support (Abstract and Fig 1), energy (acoustic wave) forming means to dislodge particulate matter (Col 3 lines 1-20) and means to remove particulate matter (Col 4 lines 45-57).

Sayka et al fail to disclose means for applying a sacrificial coating of a polymer, curing and removal of particulate matter with it.

Malotky discloses an apparatus for removing material from a surface by spraying a polymer in solution or suspension which cross links to a film which is removable by stripping (Abstract).

Therefore it would have been obvious for one of ordinary skill in the art at the time of invention to have used strippable polymer material to encapsulate dislodged particles from the substrate of Sayka et al in order to safely and completely remove contaminate particulate matter from the substrate.

***Response to Arguments***

Applicant's arguments filed 10/19/2006 have been fully considered but they are not persuasive.

In response to applicant's arguments regarding the deficiency of Sayka et al it is noted that unobviousness cannot be established by attacking the references individually when the rejection is based on a combination of references. *In re Novak* 16 USPQ 2d 2041, 2043 (Fed. Cir., BPAI 1989); *EWP Corp. v. Reliance Universal Inc.* 225 USPQ 20 (Fed. Cir. 1985); *In re Keller* 208 USPQ 871 (CCPA 1981); *Ex parte Varga* 189 USPQ 204 (PO BdPatApp 1973); *Ex parte Campbell* 172 USPQ 91 (PO BdPatApp 1971); *In re Scheckler* 168 USPQ 716 (CCPA 1971); *In re Young* 159 USPQ 725 (CCPA 1968); *In re Lyons* 150 USPQ 741 (CCPA 1966).

Further, quoted from Malotky

"A novel method and process for applying a tailor-made polymer film system a metal surface for the purpose of immobilizing and decontaminating hazardous chemicals from the said surface using a polymer that will take up the undesirable materials by solution, absorption **adsorption and hold such undesirable materials in solid suspension with subsequent stripping** of the polymeric material." clearly indicates particulate matter going in to polymer film which could be stripped.

Further, applicant is reminded that the claims are directed to an apparatus and the cited prior art discloses beyond, what would be necessary to prove a prima facie case of obviousness.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ram N. Kackar whose telephone number is 571 272 1436. The examiner can normally be reached on M-F 8:00 A.M to 5:P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Parviz Hassanzadeh can be reached on 571 272 1435. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1763

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ram Kackar  
Primary Examiner AU 1763